

DOCKET NO. 2002.04.001.WS0
U.S. SERIAL NO. 10/066,248
PATENT

REMARKS

Claims 1-20 were originally filed in the present application.

Claims 1-20 were previously cancelled.

Claims 21-40 were rejected in the March 23, 2006 Office Action.

No claims have been allowed.

Claims 21, 28, 30, 32, 34, 35 and 37 are amended herein

Claims 21-40 remain in the present application.

Reconsideration of the claims is respectfully requested.

In Section 1 of the March 23, 2006 Office Action, the Examiner objected to Claims 8, 14, 17, 21-23, 24, 26-28, 30, 32, 34, 35 and 37 based on informalities. Applicant respectfully disagrees.

With respect to Claims 8, 14 and 17, these claims were cancelled in Applicant's previous submission dated January 17, 2006. Accordingly, the objections to Claims 8, 14 and 17 are moot.

With respect to several of the claims, the Examiner cites to antecedent basis informalities. Every effort has been made to correct antecedent basis issues in all of the claims, regardless of whether the Examiner specifically objected to them. For example, Claims 28, 30, 32, 34, 35 and 37 have been amended solely to correct antecedent basis errors. No substantive changes to the claims have been made. Accordingly, Applicant respectfully requests that the objection to any claim informalities be withdrawn.

DOCKET No. 2002.04.001.WS0
U.S. SERIAL NO. 10/066,248
PATENT

Finally, with respect to Claims 21, 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37, the Examiner cites that the limitation of "capable of" is used. Taking for instance referring to Claim 21, the Examiner justifies ignoring the claim limitation "capable of" by citing MPEP §2111.04. MPEP § 2111.04 indicates that the determination of whether clauses (such as "adapted to/for," or "wherein/whereby") are a limitation in a claim is not subject to a per se rule, but instead depends on the specific facts of the case. MPEP § 2111.04, p. 2100-55 (8th ed., rev. 4, October 2005). When such a clause states a condition that is material to patentability, the clause cannot be ignored in order to change the substance of the invention. *Id.* In contrast, the "capable of" limitation in Claim 21 imposes, for example, a capability requirement on the source base station – *i.e.*, the source base station must be able to communicate with a mobile station and a target station. As another example, Claim 21 also imposes a capability requirement on the target base station – *i.e.*, the target base station must be able to communication with said source base station. Similar arguments hold true for Claims 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37. Thus, each "capable of" limitation in Claims 21, 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37 imposes a capability requirement on a claim element. Moreover, the Examiner is invited to consider the non-precedential BPAI decision in *Ex parte Prall*, Appeal No. 2003-1556, which may be electronically accessed at: www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf. The limitation at issue in *Prall* imposed a capability requirement on the respective claim element – like that in the current application. Accordingly, Applicant respectfully requests that the objection to Claims 21, 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37 be withdrawn.

L:\ASAMS01\00191

-12-

DOCKET NO. 2002.04.001.WS0
U.S. SERIAL NO. 10/066,248
PATENT

In Section 2 of the March 23, 2006 Office Action, the Examiner rejected Claims 21, 22 and 28 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,167,270 to *Rezaiifar, et al.* (the "Rezaiifar reference"). Applicant respectfully disagrees.

The Rezaiifar reference, for example, teaches a channel structure for use in communication systems in which there are two sets of physical channels, one for forward link and another for reverse link, to facilitate communication of a variety of logical channels. The Rezaiifar reference, column 3, lines 6-10. The Rezaiifar reference illustrates the use of the inter-cell Δ power levels to control forward supplemental channel transmission. *Id.* at column 13, lines 12-25 and FIGURES 5A and 5B. Specifically, if a remote station transmits the inter-cell Δ power level to bases stations indicating that the forward link power from one base station (e.g., BS C) is higher than the power level received from another base station (e.g., BS A), then the forward supplemental channel transmission is switched from BS A to base station BS C. *Id.* The Rezaiifar reference goes on to teach that the inter-cell Δ power levels may be used to assign different rates to each of the carriers, but *fails* to teach a source base station capable of handing off said supplemental channel to said target base station during said high speed packet data call. *Id.* at column 13, lines 38-39.

Accordingly, the Rezaiifar reference fails to disclose, for example, a source base station capable of handing off said supplemental channel to said target base station *during said high speed packet data call*, as required by independent Claim 21 and its dependant, Claim 22. Similarly, the Rezaiifar reference fails to disclose a method comprising the step of *handing off a high speed packet data call* from said source base station to said target base station on said supplemental channel, as

L:\SAMS01\00191

-13-

DOCKET No. 2002.04.001.WS0
U.S. SERIAL NO. 10/066,248
PATENT

required by Claim 28. Accordingly, Claims 21, 22 and 28 are patentably distinguishable over the art cited and are thus allowable.

In Section 3 of the March 23, 2006 Office Action, the Examiner rejected Claims 23 and 29 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference as applied to Claim 22 above and in view of U.S. Patent Publication No. 2002/0141370 to *Arbol* (the “Arbol reference”). Applicant respectfully disagrees.

As shown above, the Rezaiifar reference fails to disclose, for example, a source base station capable of handing off said supplemental channel to said target base station *during said high speed packet data call*, as required by independent Claim 21 and its dependant, Claims 22 and 23. As also shown above, the Rezaiifar reference fails to disclose a method comprising the step of *handing off a high speed packet data call* from said source base station to said target base station on said supplemental channel, as required by Claim 28, and its dependant Claim 29.

In addition, the Examiner cites to the Arbol reference solely for activating a non-retransmission mode of Radio Link Protocol (RLP) in the source base station and in the target base station. The Arbol reference discloses a very narrow system directed to establishing a connection that supports multiple grades of services with a single IP address assigned to the mobile station by converting data packets into byte streams suitable for transmission through Radio Link Protocol (RLP) connections. The Arbol reference, paragraph [0013]. Although the Examiner suggests that the motivation to combine the Arbol reference with a reference for using channel structure for use in communication systems in which there are two sets of physical channels, one for forward link and

DOCKET NO. 2002.04.001.WSO
U.S. SERIAL NO. 10/066,248
PATENT

another for reverse link, to facilitate communication of a variety of logical channels (the Rexaiifar reference) lies in minimizing transmission delay. Applicant respectfully disagrees.

The Rezaiifar reference, either taken alone or in combination with the Arbol reference, fails to teach or disclose a source base station capable of handing off said supplemental channel to said target base station *during said high speed packet data call*, as required by independent Claim 21 and its dependant, Claim 23. As also shown above, the Rezaiifar reference fails to disclose a method comprising the step of *handing off a high speed packet data call* from said source base station to said target base station on said supplemental channel, as required by Claim 28, and its dependant, Claim 29. Moreover, there is no motivation or suggestion within the Rezaiifar reference or the Arbol reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by cancelled Claims 23 and 29. Accordingly, Claims 23 and 29 are patentably distinguishable over the art cited and are thus allowable.

In Section 4 of the March 23, 2006 Office Action, the Examiner rejected Claims 24, 25 and 30-33 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of U.S. Patent Publication No. 2002/0147020 to *Iguchi, et al.* (the "Iguchi reference"). Applicant respectfully disagrees.

Claims 24 and 25 ultimately depend from allowable Claim 21 and are thus also allowable. Similarly, Claims 30-33 ultimately depend from allowable Claim 28 and are thus also allowable. In addition, the Iguchi reference discloses a system for setting channels of variable bandwidths, such as a supplementary channel, in a mobile communication system. The Iguchi reference, ¶ [0013].

DOCKET NO. 2002.04.001.WS0
U.S. SERIAL NO. 10/066,248
PATENT

However, the Rezaiifar reference, either alone or in combination with the Iguchi reference, fails to teach or disclose, for example, fails to teach or disclose a source base station capable of handing off said supplemental channel to said target base station *during said high speed packet data call*, as required by independent Claim 21 and thus Claims 24 and 25. Similarly, the Rezaiifar reference, either alone or in combination with the Iguchi reference, fails to disclose or teach a method comprising the step of *handing off a high speed packet data call* from said source base station to said target base station on said supplemental channel, as required by Claim 28 and thus Claims 30-33. Moreover, there is no motivation or suggestion within the Rezaiifar reference or the Iguchi reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 24, 25 and 30-33. Accordingly, Claims 24, 25 and 30-33 are patentably distinguishable over the art cited and are thus allowable.

In Section 5 of the March 23, 2006 Office Action, the Examiner rejected Claim 26 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Iguchi reference as applied to Claim 24 and in further view of U.S. Patent No. 6,947,398 to *Ahmed, et al.* (the "Ahmed reference"). Applicant respectfully disagrees.

Claim 26 ultimately depends from allowable Claim 21 and is thus also allowable. In addition, the Ahmed reference discloses a system for addressing a packet-based multi-access mobile communications system by using a protocol layer above a medium access control (MAC) protocol layer and a physical protocol layer of the system and below a transport/network protocol layer. The Ahmed reference, column 3, lines 56-62. However, the Rezaiifar reference, either alone or in

DOCKET NO. 2002.04.001.WSO
U.S. SERIAL NO. 10/066,248
PATENT

combination with the Iguchi reference and the Ahmed reference, fails to teach or disclose, for example, fails to teach or disclose a source base station capable of handing off said supplemental channel to said target base station *during said high speed packet data call*, as required by independent Claim 21 and thus Claim 26. Moreover, there is no motivation or suggestion within the Rezaiifar reference, the Iguchi reference or the Ahmed reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claim 26. Accordingly, Claim 26 is patentably distinguishable over the art cited and is thus allowable.

In Section 6 of the March 23, 2006 Office Action, the Examiner rejected Claim 27 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Iguchi reference and the Ahmed reference as applied to Claim 26 and in further view of U.S. Patent No. 5,329,635 to *Wadin, et al.* (the "Wadin reference"). Applicant respectfully disagrees.

Claim 27 ultimately depends from allowable Claim 21 and is thus also allowable. In addition, the Wadin reference discloses a system for seamless handoff in second generation cordless telephones by monitoring the received signal strength indicator (RSSI). The Wadin reference, column 1, lines 10-17 and column 2, lines 56-57. However, the Rezaiifar reference, either alone or in combination with the Iguchi reference and the Wadin reference, fails to teach or disclose, for example, fails to teach or disclose a source base station capable of handing off said supplemental channel to said target base station *during said high speed packet data call*, as required by independent Claim 21 and thus Claim 27. Moreover, there is no motivation or suggestion within the Rezaiifar reference, the Iguchi reference or the Ahmed reference to prompt one of ordinary skill to

DOCKET NO. 2002.04.001.WSO
U.S. SERIAL NO. 10/066,248
PATENT

selectively and non-inventively combine and then *seek out* still other elements as required by Claim 27. Accordingly, Claim 27 is patentably distinguishable over the art cited and is thus allowable.

In Section 7 of the March 23, 2006 Office Action, the Examiner rejected Claims 34-38 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Abrol reference, Iguchi reference, Ahmed reference and the Wadin reference. Applicant respectfully disagrees.

The Rezaiifar reference, either alone or in combination with the Abrol, Iguchi reference, the Ahmed reference and the Wadin reference, fails to teach or disclose, for example, a method for *handing off a high speed packet data call* from said source base station to said target base station, said method comprising *handing off a high speed packet data call from said source base station to said target base station on said supplemental channel*, as required by Claim 34, and its dependents, Claims 35-38. Moreover, there is no motivation or suggestion within the Rezaiifar reference, Abrol reference, Iguchi reference, Ahmed reference or the Wadin reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 34-38. Accordingly, Claims 34-38 are patentably distinguishable over the art cited and are thus allowable.

In Section 8 of the March 23, 2006 Office Action, the Examiner rejected Claims 39 and 40 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Abrol reference, Iguchi reference, Ahmed reference and Wadin reference as applied to Claim 34 and further in view of IS-95 CDMA and cdma2000 textbook by *Garg* (the "CDMA reference"). Although the Examiner cites to Claim 14 in page 16 of the March 23, 2006 Office Action, Applicant will assume this was in

L:\SAMS01\00191

-18-

DOCKET NO. 2002.04.001.WS0
U.S. SERIAL NO. 10/066,248
PATENT

error and that the Examiner meant to refer to Claim 34. Applicant respectfully disagrees with rejection.

Claims 39 and 40 ultimately depend from allowable Claim 34 and are thus also allowable. In addition, the CDMA reference discloses sending a handoff request during soft handoff setup. The CDMA reference, FIGURE 10-8. However, the Rezaiifar reference, either alone or in combination with the Abrol reference, the Iguchi reference, the Ahmed reference, the Wadin reference or the CDMA reference, fails to teach or disclose, for example, a method for *handing off a high speed packet data call* from said source base station to said target base station, said method comprising *handing off a high speed packet data call from said source base station to said target base station on said supplemental channel*, as required by Claim 34, and thus Claims 39 and 40. Moreover, there is no motivation or suggestion within the Rezaiifar reference, Abrol reference, Iguchi reference, Ahmed reference, the Wadin reference or the CDMA reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 39-40. Accordingly, Claims 39 and 40 are patentably distinguishable over the art cited and are thus allowable.

LASAMS01\00191

-19-

DOCKET No. 2002.04.001.WS0
U.S. SERIAL No. 10/066,248
PATENT

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.


Respectfully submitted,

MUNCK BUTRUS, P.C.

Date:

23 May 2006

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@munckbutrus.com*


John T. Mockler
Registration No. 39,775